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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/463,525	01/26/00	BERNARD J	RN97085

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EXAMINER	
SERGENT, R	
ART UNIT	PAPER NUMBER
1711	6

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/463,525	Applicant(s) Bernard
	Examiner Rabon Sergent	Group Art Unit 1711

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *27-55* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *27-55* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *4*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claims 27-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has failed to define "non-carbon-based carboxylic function".

2. Claims 27-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what constitutes a "non-carbon-based carboxylic function".

Within claims 31-33, it is unclear what is meant by "which have reacted with any agent bearing carboxylic functions, on the other hand" and "which have reacted with any agent bearing carboxylic functions". It would seem that these would be included within the previous "masked" language, since the carboxylic acid containing compound has been referred to as a masking agent.

Within claims 37-41, "said masking agent containing a carboxylic function" lacks antecedent basis.

Within claim 41, the variables, Y and R, have not been defined. Furthermore, the sum within the last line does not correspond to the specification and appears to be incorrect in that at least one of R or Z or OH can never be present. How would compounds which lack carboxyl groups or hydroxyl groups work in the invention?

Within claims 47-51, "said masked aliphatic function" (claim 47) and "said aliphatic function" (claim 48) lack antecedent basis. Also, the use of "type" within line 2 of claim 47 so extends the scope of the term that it is rendered indefinite.

Within claims 49-51, it is unclear that constitutes "several". It is unclear what functions are encompassed by aliphatic functions. The language, "advantageously two", renders the claim indefinite, because it is unclear if or to what extent the advantageous language modifies the less advantageous language.

Within claim 52, "the masking agent not bearing a carboxylic function" lacks antecedent basis.

3. Claims 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been provided for the sum of n, m, and p.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 27-43, 46-51, and 55 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No.08/960,620 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. Each application is drawn to the blocking of polyisocyanates with carboxylic function containing blocking agents.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 27-43, 46-51, and 55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-10, 13, and 15-27 of copending Application No. 08/960,620. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to blocking polyisocyanates with carboxylic function containing blocking agents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 27-43, 46-51, and 55 are directed to an invention not patentably distinct from claims 1, 4-10, 13, and 15-27 of commonly assigned 08/960,620. Specifically, each set of claims is drawn to blocking polyisocyanates with carboxylic function containing blocking agents.

9. Commonly assigned 08/960,620, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue,

the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

10. Claims 27-43, 46-51, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 680,984.

The reference discloses the blocking of polyisocyanates with carboxylic function containing blocking agents and their use within powder paints.

11. Claims 35, 36, 44, 45, and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 680,984 in view of JP 850290248.

As aforementioned, the primary reference discloses the blocking of polyisocyanates with carboxylic function containing blocking agents. While the use of acid moieties within the carboxylic function containing compounds is disclosed, their use is not preferred. Still, their use within blocking agents was known at the time of invention, as further disclosed by JP 850290248. See abstract. Therefore, the position is taken that it would have been obvious to utilize such acid containing compounds within the primary reference, so as to arrive at the instant invention. The position is further taken under the provisions of MPEP 2144.03 that it was known at the time of

invention to use mixtures of blocking agents, so as to control cure profiles, and tertiary amines or organic bases within carboxylic acid containing compositions, so as to neutralize the acid groups.

12. Claims 27-55 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 56167.

The reference discloses the combined use of carboxylic function containing masking agents and conventional masking agents to block polyisocyanates, which are to be used in powder coatings.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

RABON SERGENT
PRIMARY EXAMINER

Sergent/af

April 5, 2001